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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/595,515 | 06/15/2000 | Judy Glenna Shannon | KINGP.55031 | 1096 |

7590

04/26/2002

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EXAMINER

SMITH, RICHARD A

ART UNIT

PAPER NUMBER

2859

DATE MAILED: 04/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/595,515

Applicant(s)

SHANNON ET AL.

Examiner

R. Alexander Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 34 and 35 is/are allowed.
- 6) ☒ Claim(s) 16-25 and 28-33 is/are rejected.
- 7) ☒ Claim(s) 26 and 27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Continued Prosecution Application

1. The request filed on 31 January 2002 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/595,515 is acceptable and a CPA has been established. An action on the CPA follows.

Double Patenting

2. Applicant is advised that should claim 34 be found allowable, claim 26 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. Similarly, should claim 35 be found allowable, claim 27 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

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Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 16, 18-25, 28, 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey et al. in view of Crane.

Bailey et al. teaches a bookmark having a flexible, elastic intermediate member or ribbon A having opposed ends. Hooks (anchors) B are attached to each of the ends.

Bailey et al. does not teach the anchors including features of a character.

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Crane teaches a bookmark having an intermediate member or ribbon with a predetermined length and width and a loop. A first abutment member in the form of a woman's head is attached to a first end of the intermediate member, and a second abutment member in the form of legs is attached to a second end of the intermediate member. When the bookmark is used with a book, the abutment members have a thickness in a direction substantially perpendicular to the length of the spine.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Bailey et al. by adding the first abutment member of Crane to the top hook of Bailey et al., and adding the second abutment member of Crane to the lower hook of Bailey et al., since Crane teaches that providing a bookmark with upper and lower character portions is beneficial for increasing the aesthetic appeal of the bookmark.

With specific regard to claim 19, the depictions of Crane are considered to be "cartoon character features", since it is clear that the broad class of cartoons can include the depictions of Crane.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to additionally modify Bailey et al. by including an upper torso and limbs with the first abutment member and by including a lower torso with limbs with the second abutment member, as a choice of design, for the purpose of making a more appealing bookmark. One it is known to utilize parts of a human for the decorative effect of a bookmark, it is merely a choice of aesthetic design to include additional parts of the human body.

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With specific regard to claims 23 and 28, since the intermediate member can be coiled around the lower limbs of the proposed modified device of Bailey et al., the lower limbs are considered to be constructed to retain a coiled portion of said intermediate member therebetween.

With regard to the top and bottom anchors being "plush", such would have been obvious to one having ordinary skill in the art at the time the invention was made, since it is clear that "plush" abutments would be beneficial since they would not scratch or otherwise mar objects while the bookmark is in use.

With regard to claims 25 and 33, the hooks of Bailey et al. are constructed for releasable engagement with each other, since they can be hooked together if desired. Also, with regard to claim 33, the preamble and the functional language "may be wrapped around an individual's wrist..." are not sufficient to set forth sufficient structure to patentably distinguish the claimed invention from the prior art.

5. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey et al. in view of Crane as applied to claims 16, 18-25, 28, 32 and 33 above, and further in view of Ward et al.

Bailey et al. and Crane together teach all that is claimed, as discussed in the above rejection of claims 16, 18-25, 28, 32 and 33, except for the intermediate member being made from an elastomeric material.

Ward et al. teaches a bookmark with an elastomeric band A, a plurality of hooks on the band, and a line indicator on the band.

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify Bailey et al. by replacing the intermediate member thereof with the elastic band of Ward et al., since Ward et al. teaches that an elastomeric band is suitable for bookmarks that require stretching to accommodate books of various size. This proposed modification can result in the intermediate member being round as taught by Bailey et al., or flat as taught by Ward et al.

6. Claims 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey et al. in view of Crane as applied to claims 16, 18-25, 28, 32 and 33 above, and further in view of Cox.

Bailey et al. and Crane together teach all that is claimed, as discussed in the above rejection of claims 16, 18-25, 28, 32 and 33, except for the first and second abutments being three-dimensional.

Cox teaches a book marker with a three dimensional ornamental element thereon. The element is in the form of a human face.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify Bailey et al. by making the first and second abutments three-dimensional, since Cox teaches that three dimensional ornamental elements are known for providing a desired ornamental effect.

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Allowable Subject Matter

7. Claims 34 and 35 are allowed.
8. Claims 26 and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
9. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Response to Arguments

10. Applicant's arguments filed 31 January 2002 have been fully considered but they are not persuasive.

The Applicant's argument with respect to Bailey et al. abutting the spine of the book and not abutting the outside ends of the pages of the book is not persuasive since the book with spine and pages are recited in the claims as intended use, and a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in

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order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore Ward et al. discloses a similar bookmark wherein the hooks B act similarly to the hooks C of Bailey except that the hooks B of Ward act as abutments against pages of a book.

In response to applicant's argument that Crane does not teach or suggest abutment members, that the head and feet portions appear to be the same thickness as the intermediate ribbon portion, and that there is no need or suggestion to provide abutment means on the hooks, it is the position of the examiner that the "head" and "legs" of Crane are abutment members since they are capable of abutting against surfaces of a book and being thicker than the intermediate ribbon portion in order to abut against the surfaces of a book. However, whether or not the "head" and "legs" of Crane can be called abutment members and are thicker is essentially moot, since the abutment members of the modified device of Bailey et al. include the hooks B of Bailey which are thicker than the intermediate ribbon portion.

In response to applicant's argument that there is no suggestion to combine the references Bailey et al. and Crane, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re*

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Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, for the purpose of making the bookmark of Bailey et al. a more appealing and ornamental bookmark.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The prior art cited in PTO-892 and not mentioned above disclose related bookmarks and devices.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Smith whose telephone number is (703) 305-0647. The examiner can normally be reached on Monday-Friday from 9:00 AM to 5:30 PM.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Diego Gutierrez
Supervisory Patent Examiner
Technology Center 2800

RAS
April 16, 2002